

## **REMARKS:**

Claims 1-35 remain in the application for consideration of the Examiner.

By this Amendment, claims 1, 12, 23, 34, and 35 have been amended in order to improve the grammar of these claims. These amendments are not necessitated by any prior art and are unrelated to the patentability of these claims.

Claims 1-35 stand rejected under the second paragraph of 35 U.S.C. § 112. Claims 1-35 also stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. 2001/0014868 to Herz, et al.

## **REJECTION UNDER 35 U.S.C. § 112:**

Claims 1-35 stand rejected under the second paragraph of 35 U.S.C. § 112. This rejection is respectfully traversed as follows.

With respect to the recitation of “a plurality of search results” and the subsequent recitation of “one or more search results,” the allegation that these recitations render the claim indefinite is respectfully traversed. It is respectfully submitted that the assertion in the Office Action that “a ‘plurality of search results’ can not comprise one search result” is not only inaccurate, but also ignores the context in which the phrase “one or more search results” is presented. It is appreciated that “a plurality of items” means more than one item; however, it is equally true that “more than one item” necessarily *comprises* “one item,” albeit in combination with at least one additional item. It should also be noted that the claim actually recites “the [plurality of] search results comprising one or more search results *reflecting product data for a particular seller.*” (Emphasis added). As those skilled in the art would appreciate, the plurality of search results can include, for example, one search result reflecting product data for a particular seller and another search result for a different seller. This would be analogous to claiming “a plurality of widgets” that *comprise* “one or more blue widgets.” Since the plurality of widgets can include widgets of other colors, it would not be incorrect to say that the plurality of widgets includes one blue widget. Thus, the recitation of “a plurality of search results...comprising one or more

search results reflecting product data for a particular seller” is considered to be sufficiently clear so as to comply with the requirements of 35 U.S.C. § 112.

With respect to the recitation of “the search results comprising one or more search results,” the allegation that this phrase renders the claim unclear is respectfully traversed. Again, it appears that this phrase has been pulled from the claim without regard to the context in which the phrase is presented in the claim. Note that MPEP 2173.02 instructs that “[i]n reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim *as a whole*....” (Emphasis added). Borrowing from the example above, there is nothing unclear about saying that “a plurality of widgets comprises one or more widgets *having a blue exterior*.” Similarly, with respect to claim 1, those skilled in the art would readily appreciate the meaning of “the search results comprising one or more search results *reflecting product data for a particular seller*.” (Emphasis added).

The suggestion in the Office Action of alternative claim language is noted with appreciation. However, for reasons stated above, the claims in their present form are considered to be in compliance with the requirements of 35 U.S.C. § 112.

In light of the above, it is respectfully submitted that claims 1-35 are fully compliant with the requirements of 35 U.S.C. § 112. Accordingly, it is respectfully requested that the rejection of claims 1-35 under 35 U.S.C. § 112 be reconsidered and withdrawn.

#### **REJECTION UNDER 35 U.S.C. § 102:**

Claims 1-35 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. 2001/0014868 to Herz, et al. (“Herz”). However, because Herz fails to disclose all of the limitations of claims 1-35, Herz cannot anticipate claims 1-35.

The specificity, clarity, and thoroughness of the Examiner’s comments is noted with appreciation.

The MPEP includes certain standards for establishing that a claim is anticipated by a reference under § 102. For example, MPEP 2131 states that “to anticipate a claim, the

reference must teach *every element* of the claim.” (Emphasis added.) MPEP 2131 points to case law that supports and explains this requirement. In particular, MPEP 2131 provides that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”<sup>1</sup> MPEP 2131 further provides that “[t]he identical invention must be shown *in as complete detail as is contained in the ... claim.*”<sup>2</sup> (Emphasis added.)

With these standards in mind, attention is first drawn to claim 1. This claim recites *inter alia* “providing at least some of the recorded query information, presentation information, or selection information to the particular seller to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers.” Note that “presentation information” is defined earlier in the claim to include being “associated with the manner in which a plurality of search results are presented.” Also note that “selection information” is defined earlier in the claim to include being “associated with the selection by the buyer of a particular search result.” Based on the standards set forth in the MPEP for establishing anticipation, Herz cannot anticipate claim 1 unless each and every element of claim 1 is expressly or inherently described in Herz in as complete detail as is contained in claim 1. Since Herz fails to either expressly or inherently describe at least the above-cited portions of claim 1 in as complete detail as is contained in claim 1, Herz cannot anticipate claim 1.

It is noted that the Office Action alleges that “providing a pricing structure for better shelf space to merchants represents providing at least some of the information to a seller.” (Emphasis in original.) However, this allegation is respectfully traversed. Herz does appear to disclose the concept of virtual stores and charging sellers based on virtual shelf space. Nevertheless, Herz fails to disclose providing recorded query information, presentation information, or selection information to a seller.

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<sup>1</sup> MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>2</sup> MPEP 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

There is also no evidence that providing such information to a seller is inherent to the disclosure of Herz. Rather, Herz discusses “better shelf space” in terms of virtual “store fronts,” where perhaps merchants might pay a premium for more prominent product placement on a web site. Regarding the value of such placement, Herz provides that “[t]he value of ‘shelf space’ may be appraised automatically by cross correlating the purchasing response of similar shoppers to an identical item located in different shelf locations through out the virtual store.”<sup>3</sup> The value of such placement does not reasonably seem to involve knowledge of presentation information, selection information, or query information associated with a search query or results of a search query. Instead, Herz indicates that the value is tied to sales volume. Thus, there would be no reason to provide sellers with presentation information, selection information, or query information associated with a search query or results of a search query.

Therefore, for at least the reasons stated above, it is respectfully submitted that Herz fails to disclose, either expressly or inherently, all of the limitations of claim 1. Since claims 2-11 depend from claim 1 and necessarily include all of the limitations of claim 1, Herz cannot anticipate claims 2-11 for at least the same reasons discussed above in connection with claim 1.

With respect to claims 12, 23, 34, and 35, each of these claims includes limitations similar to those discussed above in connection with claim 1. Accordingly, Herz cannot anticipate claims 12, 23, 34, or 35 for at least the same reasons discussed above in connection with claim 1. Similarly, since claims 13-22 depend from claim 12 and necessarily include all of the limitations of claim 12, and claims 24-33 depend from claim 23 and necessarily include all of the limitations of claim 23, Herz cannot anticipate claims 13-22 and 24-33 for at least the same reasons discussed above in connection with claim 1.

In light of the above, it is respectfully submitted that claims 1-35 are in condition for allowance, and notice to that effect is respectfully requested.

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<sup>3</sup> Herz, page 27, paragraph 0260, lines 3-7.

## **THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.

2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.

3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent

application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.



**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.


The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing the Amendment to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

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Date

  
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